

NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

2007-1047, -1075, -1076
(Serial Nos. 09/754,378, 09/321,597, and 09/543,735)

IN RE CRAIG W. BARNETT, KAREN R. REISNER,
and MARK BRAUNSTEIN

Judgment

ON APPEAL from the UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

in CASE NO(S): 09/754,378, 09/321,597, and 09/543,735

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

Per Curiam (SCHALL, BRYSON, AND MOORE, Circuit Judges.)

AFFIRMED. See Fed. Cir. R. 36.

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

OCT 11 2007

JAN HORBALY
CLERK

DATED OCT 11 2007

ENTERED BY ORDER OF THE COURT

Jan Horbaly

Jan Horbaly, Clerk

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UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

ISSUED AS A MANDATE: DEC 3 2007

By: *Samuel* Date: 12/3/07

NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

Corrected: October 30, 2007

2007-1047, -1075, -1076
(Serial Nos. 09/754,378, 09/321,597, and 09/543,735)

IN RE CRAIG W. BARNETT, KAREN R. REISNER,
and MARK BRAUNSTEIN

Kevin T. Kramer, Pillsbury Winthrop Shaw Pittman LLP, of Washington, DC, argued for appellants. With him on the brief were James G. Gatto, Scott J. Pivnick, and Robert M. Fuhrer, of McLean, Virginia.

Thomas L. Stoll, Associate Solicitor, Solicitor's Office, United States Patent and Trademark Office, of Arlington, Virginia, argued for appellee. With him on the brief were Stephen Walsh, Acting Solicitor, and Janet A. Gongola, Associate Solicitor.

Appealed from: United States Patent and Trademark Office,
Board of Patent Appeals and Interferences

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UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

By: [Signature] Date: 12/3/07

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

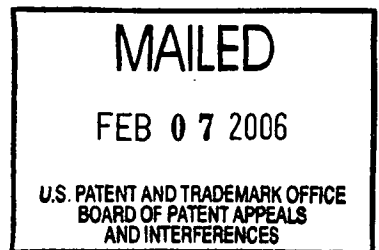
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRAIG W. BARNETT,
KAREN R. REISNER and MARK BRAUNSTEIN

Appeal No. 2005-2439
Application No. 09/754,378

HEARD: JANUARY 11, 2006



Before JERRY SMITH, GROSS, and LEVY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 76-112, which constitute all the claims pending in this application.

The disclosed invention pertains to an on-line coupon distribution system. More particularly, the invention downloads coupon information from a host computer to a client computer where a paper coupon is printed by the client computer.

Representative claim 76 is reproduced as follows:

76. A method for viewing and printing at a remote terminal user-specific incentives, the method comprising:

storing at an Internet-accessible location incentive information pertaining to a group of available incentives;

storing user profile information and user usage history information for one or more users;

receiving at the Internet-accessible location, from a user of a remote terminal, a request for access to the stored incentive information;

determining at the Internet-accessible location if the user is a registered user, and if the user is not registered:

- i) transmitting a prompt to the user's remote terminal to electronically complete a user profile;
- ii) receiving and storing the user profile; and
- iii) downloading to the user's remote terminal an incentive data management software module for managing the printing of incentives, wherein a printed incentive includes unique user identification information;

if the user is registered, the user viewing a subset of incentives from the group of available incentives, the subset of incentives being based on user-specific information, which comprises at least one of the user profile information and the user usage history information;

the user selecting one or more incentives from the subset of incentives for printing, each of the one or more incentives comprising various fields, including a redemption amount field and at least one other field, the redemption amount field comprising data indicative of a discount provided by the incentive, the at least one other field being determined in accordance with user-specific information associated with the requesting user;

printing at the remote terminal, under control of the incentive data management software module, one or more of the user-selected incentives which can be redeemed by a user;

storing at the Internet-accessible location information regarding printed incentives;

subsequent to a user redeeming one or more of the printed incentives, storing redemption information;

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providing at least incentive redemption data to at least one incentive distributor or incentive issuer to enable the at least one incentive distributor or incentive issuer to use at least the incentive redemption data for market analysis to create at least one subsequent targeted incentive targeted based on targeting criteria; and

making the at least one subsequent incentive available to a user if the user satisfies the targeting criteria.

The examiner relies on the following references:

Von Kohorn	5,227,874	July 13, 1993
Saigh et al. (Saigh)	5,734,823	Mar. 31, 1998

Claims 76-112 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 63-74 of copending application Serial No. 09/321,597. Claims 76-81 and 83-89 also stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-8 of U. S. Patent No. 6,321,208. Claims 82 and 91 also stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Finally, claims 76-112 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Von Kohorn in view of Saigh.

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Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the prior art rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that appellants' specification supports the invention of claims 82 and 91. We are also of the view that the evidence relied upon by the examiner supports the examiner's prior art rejection. Accordingly, we affirm.

We consider first the examiner's rejections of the claims based on obviousness-type double patenting. We note that appellants have elected not to address these rejections in the appeal brief [brief, page 10]. Therefore, we sustain these

rejections as a mere formality although we have not considered the technical merits of the rejections.

We now consider the examiner's rejection of the claims under the first paragraph of 35 U.S.C. § 112. With respect to claim 82, the examiner objects to the phrase "wherein the at least one subsequent incentive is provided to the user via an electronic mail message" because the specification does not disclose utilizing an electronic mail message to provide coupons to the user [answer, page 4]. Appellants respond by citing several exemplary portions of the specification which allegedly support claim 82 [brief, page 12]. The examiner responds that appellants' citations only support electronic downloading of coupons, but not utilizing e-mail to provide coupons to the user [answer, page 16]. Appellants respond that an e-mail is an electronic transmittal so that the specification supports claim 82 [reply brief, pages 2-3].

We agree with appellants that the specification supports the invention of claim 82. The examiner has drawn a distinction between electronic downloading, which is supported by the disclosure, and communication by way of e-mail, which the examiner argues is not supported by the disclosure. Although appellants do not identify any portion of the specification which

specifically refers to e-mail, they argue that an e-mail is an electronic communication. Even though the specification never specifically states that coupons are sent to users by way of e-mail, we agree with appellants that the specification in its entirety would have suggested this manner of communication to the artisan. Specifically, the specification teaches that the Internet-accessible location keeps track of individual users by noting the user's on-line address. The user's on-line address is the same as the user's e-mail address. The fact that the coupon distributor has the e-mail address of each user suggests that coupons could be delivered to the user by way of e-mail. Thus, we find that the disclosed invention contemplated the use of e-mail for the distribution of coupons.

With respect to claim 91, the examiner objects to the phrase "wherein downloading the incentive data management software module comprises downloading the unique identifier" because the specification does not disclose this combination of features [answer, page 4]. Appellants respond by citing an exemplary portion of the specification and drawings which allegedly support claim 91 [brief, page 12]. The examiner responds that although the specification supports downloading uniquely identified

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coupons or coupon packages, it does not support downloading the unique identifier with the downloading of the incentive data management software module [answer, page 16]. Appellants respond by citing additional portions of the specification to support the invention of claim 91 [reply brief, page 3].

We agree with appellants that the specification supports the downloading of the unique identifier as part of the downloading of the incentive data management software module. The alternative embodiment described at the bottom of page 32 clearly discloses that the downloaded coupon management routines are encoded with a unique user identification number. This disclosure supports the recitation of claim 91.

Therefore, we do not sustain the examiner's rejection of claims 82 and 91 for the reasons discussed above.

We now consider the rejection of claims 76-112 under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Von Kohorn and Saigh. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual

determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ

685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the briefs have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

With respect to independent claims 76 and 112, the examiner's rejection essentially finds that Von Kohorn teaches every feature of these claims except that Von Kohorn does not explicitly disclose that the communication channel is the Internet. The examiner cites Saigh as teaching use of the Internet to transmit coupons to a user. The examiner finds that it would have been obvious to the artisan to use the Internet as taught by Saigh to transmit coupons in Von Kohorn [answer, pages 4-7].

Appellants make the following arguments: 1) that the applied prior art is non-analogous art; 2) that there is no motivation to modify the teachings of Von Kohorn with the teachings of Saigh; and 3) the collective teachings of Von Kohorn and Saigh fail to teach all of the claim elements. With respect to the first

argument, appellants argue that Von Kohorn and Saigh are outside appellants' field of endeavor, which is said to be the electronic distribution of coupons in a way which reduces fraud. Appellants also argue that the applied references are not reasonably pertinent to the problems with which appellants were involved. Appellants list several problems in support of this contention [brief, pages 14-18]. The examiner responds by citing several portions of Von Kohorn and Saigh which, according to the examiner, demonstrate that Von Kohorn and Saigh teach all of the claim elements. Appellants respond that Von Kohorn is not primarily directed to a coupon distribution system. Appellants also respond that Von Kohorn and Saigh are not concerned with deterring fraud in print-at-home coupons or tracking user activity [reply brief, pages 3-8].

We are not persuaded by appellants' arguments that Von Kohorn and Saigh are non-analogous art. Independent claim 76 recites a method of viewing and printing at a remote terminal user-specific incentives. There is no question that Von Kohorn prints user-specific coupons at user terminals. The fact that Von Kohorn also teaches a method for measuring the effectiveness of different stimuli on user purchases does not detract from the

fact that Von Kohorn also teaches a coupon distribution system as claimed. Von Kohorn also teaches that the disclosed method is useful for preventing forged coupons [see for example, column 16, lines 55-58 and column 17, lines 10-20]. With respect to Saigh, it was cited to show that it was known to use the Internet to distribute coupons on demand. Although Saigh has much wider applicability than the distribution of coupons, it is clearly analogous art with respect to the claimed distribution of coupons. Therefore, we find that Von Kohorn and Saigh are analogous art with respect to the claimed invention.

With respect to the second argument noted above, appellants argue that the proposed modification would render Von Kohorn unsuitable for its intended purpose and would change the principle of operation of Von Kohorn. Appellants also argue that the examiner has not properly addressed why it would have been obvious to modify the particular system of Von Kohorn to include the Internet [brief, pages 18-20]. The examiner responds that both Von Kohorn and Saigh teach the distribution of coupons to users over a network. The examiner asserts that the artisan would have been motivated to utilize the Internet in Von Kohorn to take advantage of a network that is far reaching and readily

available [answer, page 19]. Appellants respond that Von Kohorn is directed to a television broadcast system and teaches away from a computer network system [reply brief, page 9].

We are not persuaded by appellants' argument that there is no proper motivation for combining the teachings of Von Kohorn with the teachings of Saigh. The examiner's rejection is based on the findings that Von Kohorn teaches every element of the claimed invention except for the use of the Internet. These specific findings will be considered below. The examiner cites Saigh for the sole purpose of teaching that it was known to use the Internet as a way to distribute incentives, such as coupons, to users of computers. Although Von Kohorn teaches the distribution of coupons to users over a television or radio broadcast network, Von Kohorn also teaches such distribution over a closed circuit network [column 10, line 37]. Von Kohorn also defines an "interactive system" as a "system for communicating from a sender to a respondent and having the capacity for allowing the sender to receive a communication, when desired, from the respondent whether by manual or electronic means" [column 9, lines 9-13]. Thus, it appears to us that Von Kohorn contemplates any interactive network as suitable for practicing

his invention. We agree with the examiner that the artisan would have been motivated to use the Internet as the interactive network in Von Kohorn because the Internet has become accessible to nearly everyone who owns a personal computer and the Internet has become the wide area network of choice by such computer users. Thus, applying the teachings of Saigh to Von Kohorn does not render Von Kohorn inoperable for its intended purpose, but only makes an additional form of communication available to the coupon distributors.

With respect to the third argument noted above, appellants simply recite the various limitations of independent claim 76, and then assert with essentially no explanation or analysis that the portions of Von Kohorn cited by the examiner fail to teach the claim limitations [brief, pages 20-22]. The examiner responds by again citing several portions of Von Kohorn which, according to the examiner, meet the individual recitations of claim 76 [answer, pages 21-34]. Appellants respond that the rejection fails to show the following elements of claim 76:

- 1) storing the electronic coupon data at an Internet accessible location;
- 2) receiving a request for coupon data at the central location;
- 3) determining at the Internet accessible location

whether the user is registered; 4) receiving a prompt to complete a user profile; 5) selecting a subset of coupons based on user profile information and user usage information; 6) downloading the incentive data management software with a selection of the subset of incentives by the user; 7) storing information at the Internet accessible location regarding printed incentives; and 8) storing a cumulative record at the Internet accessible location [reply brief, pages 10-15].

We respond to these arguments with the understanding that we have already determined that it would have been obvious to the artisan to modify the system and method of Von Kohorn to include using the Internet as the communication channel between the coupon distributors and the coupon users. After such modification, the coupons of Von Kohorn would be sent from an Internet site to each user along with the modules necessary to control the printing of coupons. Under such circumstances, the coupon data would have to be stored at the Internet site, and the user would have to request coupons from the Internet site. Von Kohorn also discloses that a user can select a product area of interest and receive coupons for products in the area of interest [column 98, lines 39-44]. It is also well known in the art of

downloading information from Internet sites that users typically register with the site and complete certain user profile information for use by the site owner. Von Kohorn also teaches that his system and method can compile a cumulative record and determine a quantitative measurement of a shopper's buying behavior [column 2, lines 8-16]. Thus, we find that when the system and method of Von Kohorn are modified to use the Internet as taught by Saigh, each of the elements of claim 76 argued by appellants is taught or suggested by the applied prior art.

Therefore, we sustain the examiner's rejection of independent claim 76. Since appellants' arguments with respect to dependent claims 77-111 consist of nothing more than an assertion without any explanation or analysis that the passages of Von Kohorn relied on by the examiner fail to render the claimed invention unpatentable, we sustain the examiner's rejection of each of these claims because the examiner, in our view, at least established a prima facie case of obviousness with the findings set forth in the rejection. Since independent claim 112 is broader than independent claim 76, we also sustain the examiner's rejection of claim 112 for reasons discussed above with respect to claim 76.

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In summary, the examiner's double patenting rejections are sustained. The rejection under 35 U.S.C. § 112 is not sustained with respect to either claim 82 or claim 91. The rejection under 35 U.S.C. § 103(a) is sustained with respect to all claims. Therefore, the decision of the examiner rejecting claims 76-112 is affirmed.

Appeal No. 2005-2439
Application No. 09/754,378

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a)(1)(iv).

AFFIRMED

Jerry Smith

JERRY SMITH
Administrative Patent Judge

Anita Peltman Gross

ANITA PELLMAN GROSS
Administrative Patent Judge

Stuart S. Levy

STUART S. LEVY
Administrative Patent Judge

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